

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: William T. Jennings  
U.S. Patent Serial No.: 09/668,026  
Filing Date: September 21, 2000  
Examiner: Christian A. Laforgia  
Art Unit: 2131  
Title: KEY ESCROW SYSTEMS  
Attorney Docket Number: 064751.0298

MAIL STOP AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The following Pre- Appeal Brief Request for Review (“Request”) is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 (“OG Notice”). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. The Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

**REMARKS**

In the prosecution of the present Application, the Examiner’s rejections and assertions contain clear errors of law, including a failure to establish *prima facie* rejections in a Final Office Action. To assist the Panel in the review of this Request, Applicant submits the following brief summary of selected portions of the prosecution history of the Application.

**I. Brief Summary of Selected Portions of Prosecution History**

**a. Final Office Action**

In a Final Office Action of August 18, 2006 (the Final Office Action), all claims were rejected under 35 U.S.C. § 103, but as described in further details below, the Final Office Action failed to set forth a *prima facie* rejection of several of the claims.

Accordingly, Applicant filed a Response to the Final Office Action on November 20, 2006 (the Response to Final Office Action). In this response the Applicant pointed out that the Final Office Action did not establish a *prima facie* rejection of the claim under 35 U.S.C. § 103, and requested that the claims be allowed. *See* Response to Final Office Action, pages 20-23.

**b. Advisory Action**

In an Advisory Action of December 8, 2006 (the Advisory Action), the Examiner maintained the rejection of Claims 1-24 and 26-36. As shown below, however, the Advisory Action does not correct the deficiencies of the Final Office action.

**II. Errors of Record**

**a. Failure to Establish a Prima Facie Rejection**

Applicant maintains that the Final Office Action did not establish a *prima facie* rejection of all the claims in the application and that the Advisory Action did not address the deficiencies pointed out by the Applicant in the Response to the Final Office Action.

First, as Applicant showed in the Response to the Final Office Action, the cited references, alone or in combination, fail to disclose, teach or suggest each element of the independent claims 1, 6, 14, 28, and 33. *See* Response to Final Office Action, page 19-21. As Applicant pointed out in the Response to the Final Office Action, the *Merkle-Elgamal* combination do not disclose “adding randomization information at the receiver to the corresponding token of the selected trap door encryption-decryption function pair” or “encrypting the token with the added randomization information at the receiver . . . ,” as required by Claim 1. *See* Response to Final Office Action, page 19. Applicant further pointed out that the *Merkle-Elgamal* combination does not disclose similar limitations in Claim 6, 14, 28, and 33. *See* Response to Final Office Action, page 21. The Advisory Action, quoted above, does not address the failure of the cited art to show each of the elements of the independent Claims.

The Advisory Action at page 2 states:

With respect to the Applicant's allegation that the combination of references do not teach adding randomization data to the token, the Examiner kindly directs the Applicant's attention to MPEP § 2131, in particular the discussion of *ipsisimis verbis*. *Ipsissimis verbis* states that the elements of the invention must be arranged as required by the claim regardless of the identity of terminology. In other words, the fact that the references do not use the same terminology as the Applicant, yet teaches the elements of the claim language is not enough to distinguish the instant application over the prior art.

With respect to the Applicant's argument that Elgamal fails to teach "adding randomization data to a token" as defined by the Applicant's disclosure, the Examiner respectfully disagrees with the Applicant's assertion. The Applicant states that "randomization data is added to a corresponding token." The Examiner construes this to mean that data is added to the token, and that the added data is of little or no significance and has no bearing on the actual token. Elgamal states at column 17, lines 29-30 that the actual value of the padding data is unimportant, which the Examiner interprets as including randomly generated data.

Applicant respectfully disagrees. The Advisory Action is attempting to equate padding data with Applicant's randomization information because *Elgamal* does not mention randomization data. Applicant, however, maintains that the claim limitation requiring "adding randomization information at the receiver to the corresponding token of the selected trap door encryption-decryption function pair; [and] encrypting the token with the added randomization information at the receiver, the token corresponding with the randomly selected encryption-decryption function pair," is a positive claim limitation with patentable significance. The claim limitation cannot be read out simply because *Elgamal* does not care about randomization of the padding data. Furthermore, Applicant disagrees with the Advisory Action's interpretation of *Elgamal*'s padding data includes randomization data. This interpretation not supported factually by *Elgamal* and is not supported by the Advisory Action's legal interpretation that reads out Applicant's claim limitation requiring randomization information.

Second, as Applicant noted in the Response to Final Office Action, the cited art also fails to disclose that the randomization information is added at the receiver, as required by the claims. The Advisory Action did not address this deficiency in the Final Office Action. Applicant maintains that this portion of the limitation is not met by the art of record.

**II. Request for Relief from Errors**

As a *prima facie* rejection has not been established against Claims 1-24 and 26-36, Applicant respectfully requests allowance of Claims 1-24 and 26-36.

### CONCLUSION

For the reasons presented above, Applicant respectfully requests relief from the Errors of Record. If the PTO deems that an interview is appropriate, Applicant would appreciate the opportunity for such an interview.

To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

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